

Remarks

Applicant respectfully submits that entry of this amendment is proper as it places the application in condition for allowance. Furthermore, the only amendments to the claims, as well as the additional claims, reflect the incorporation of limitations that the Examiner has indicated to be allowable. As such, consideration of the amendment would not require further searching and would require only minimal consideration by the Examiner.

Claims 1-18 and 20-24 are pending. By the foregoing Amendment, claims 1, 3-4, 8 and 11, 12, and 21-23 are amended, claims 2, 5-6, 14, 16-18, 24 are withdrawn, and claim 13 is cancelled. New claims 25-26, apparatus claims directed to prosthesis, which mirror and incorporate and the limitations of the method claims 12, 13 and 15 which the Examiner indicated to be allowable, are presented. No new matter is added by this Amendment. Entry of the Amendment, and favorable consideration thereof, is earnestly requested.

Allowable Subject Matter

The Examiner has indicated that claims 3-4, 12-13 and 15 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, for the sole purpose of expediting prosecution, allowed claims 3 and 4 have been re-written in independent form, incorporating the limitations of previously presented claims 1-2 (from which it previously depended). Further, for the sole purpose of expediting prosecution, allowed claim 12 has been re-written in independent form, incorporating the limitations of claim 11 (from which it previously depended), with allowed claim 15 now properly depends from amended independent claim 12. Claim 11 has been amended to incorporate the limitations of allowed claim 13. Hence, claim 13 has been cancelled as its limitations were instead incorporated into claim 11.

Additionally, in light of the Examiner's indication of allowability of method claims 12-13 and 15, Applicant has amended claim 1 (an apparatus claim) to incorporate those limitations (specifically of allowed claim 13.) Likewise, Applicant has presented new independent claim 25 (to incorporate the limitations of allowed claim 12) and new dependent claims 26 thereon (to incorporate the limitations of allowed claim 15). No new matter is added by these amendments. Specifically, independent claims 1 and 25 and dependent claim 26 merely reflect the incorporation of the main limitations of allowed method claims 12-13 and 15 as well as apparatus limitations of allowed claims 3-4. Applicant respectfully submits that the incorporated limitations sufficiently distinguish the invention recited in amended claim 1 and new claims 25-26 from the prior art for the same reasons the Examiner has deemed original claims 3-4, 12-13 and 15 allowable. Previously presented apparatus claims 8-10 and 20-23, dependent on claim 1, merely recite further limitation to those claims already indicated to be allowable by the Examiner, and hence, are likewise allowable.

Claims 21-23 have been amended to merely correct informalities.

Specification

Additionally, the Examiner has objected to the use of term "biologically compatible rupture indicator" stating that the specification uses the terminology "chemical indicator." Applicant respectfully disagrees. Within Applicant's specification, the terminology of "chemical indicator," "biologically compatible chemical indicator for indicating **rupture**," "biologically compatible chemical indicator," and "**rupture** indicator" are used throughout interchangeably. The terminology "chemical indicator" is used on page 6 (lines 1 and 23), page 7 (lines 1 and 2), and page 8 (line 1). The terminology "biologically compatible chemical indicator" is used at page 6 (line 18) and page 7 (line 7). The terminology "biologically compatible chemical indicator **for indicating rupture**" is used at page 1 (lines 14-15), page 5 (lines 17-18), and page 7 (line 7 and line 10). The terminology of "rupture indicator" is used at page 5 (line 16) and page 7 (line 21). Appli-

cant has amended all independent claims herein to recite fully a "biologically compatible chemical rupture indicator," and in all claims dependent thereon, "the rupture indicator" to overcome the Examiner's objection.

Claim Rejections under 35 U.S.C. §101

The Examiner has rejected claim 8 under 35 U.S.C. §101 as the directed to non-statutory subject matter, specifically as it claims portions of the body. Per the Examiner's suggestion, Applicant herein has amended claim 8 to recite "implantable in" rather than "implanted in," to overcome this rejection.

Claim Rejections under 35 U.S.C. §102 and 35 U.S.C. §103

The Examiner has rejected claims 1-2 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,100,627 to Brill III. The Examiner has rejected claims 1, 7-10, 20-23 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,969,899 to Cox. The Examiner has rejected claims 1, 7-8, and 11 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,795,463 to Gerow et al.

For the sole purpose of expediting prosecution, Applicant herein has amended independent claims 1 and 11 to include limitations that the Examiner has indicated to be allowable in order to overcome these rejections and to proceed with the claims indicated by the Examiner to be allowable. Applicant has traversed the present rejection of amended claim 1, its dependent claims 7-8 and 20-21, amended claim 11 and its dependent claims 22-23. Applicant reserves the right to file a continuation application directed to previously presented independent claims 1 and 11 and all claims dependent thereon, including withdrawn claims 2, 5-6, 14, 16-18, and 24, in order to respond to these rejections substantively therein without delaying prosecution of the allowed claims in the present application.

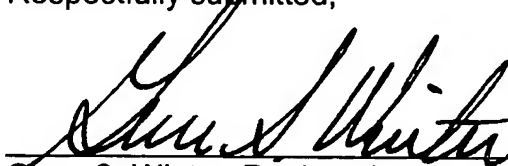
Claim Rejections under 35 U.S.C. §103

Further, the Examiner has rejected claims 1, 7-11, 20-24 under 35 U.S.C. §103(a) as being unpatentable over Cox in view of Gerow et al. For the sole purpose of expediting prosecution, Applicant herein has amended independent claims 1 and 11 to include limitations that the Examiner has indicated to be allowable in order to overcome these rejections and to proceed with the claims indicated by the Examiner to be allowable. Applicant has traversed the present rejection of amended claim 1, its dependent claims 7-10 and 20-21, amended claim 11 and its dependent claims 22-23, and has withdrawn claim 24. Applicant reserves the right to file a continuation application directed to previously presented independent claims 1 and 11 and all claims dependent thereon, including withdrawn claims 2, 5-6, 14, 16-18, 24, in order to respond to these rejections substantively therein without delaying prosecution of the allowed claims in the present application.

Conclusion

It is respectfully submitted that claims 1, 3-4, 7-12, 15, 20-23, and 25-26, all claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,



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